

REMARKS

REJECTION UNDER 35 U.S.C. § 103:

*On page 3 of the Office Action, claims 1, 2, 4, 5, 7, 8, 10-13, 16, 19-24, 26, and 27 were rejected under 35 U.S.C. § 103(a) as being obvious in view of U.S. Patent No. 6,252,588 to Dawson (“Dawson”) and “V’s Email SIG HTML.”*

On page 2 of the Office Action, the following is stated: “the features upon which the applicant relies (i.e., “the thumbnail image is not input separately from the e-mail address”) are not recited in the rejected claim(s).” Applicant respectfully asserts that the response to the Office Action filed on June 2, 2003 does not expressly or impliedly make such statement. The response indicates that the thumbnail image of Dawson is input in a box next to the box 1621 for inputting the email address. Thus, the method of Dawson separately inputs the image information and the email address. In contrast, as recited in independent claim 1, “a symbol including image information, which enables a sender to be specified therefrom, is included within an electronic signature of the electronic mail, said electronic signature file including an email address of the sender.” Emphasis added. Thus, contrary to the assertions made in the Office Action, the features upon which Applicant relies are recited in the claims. The symbol including the image information and the email address are input together, not separately, as the method described in Dawson. Column 7, lines 65-66 of Dawson, referred to by the Examiner, merely mentions signing of a message by a thumbnail portrait of the sender. In other words, instead of sending the words “Yours Truly”, a thumbnail portrait of the sender is sent with the electronic mail.

Furthermore, the Office Action indicates that, “claim 1 does not specify that the email address is separate from the image information, nor does it specify that it cannot be an image.” Independent claim 1 recites that the image information “a symbol including image information . . . is included within an electronic signature of the electronic mail,” and “said electronic signature file including an email address of the sender.” If assuming, arguendo, that the email address and the image information were to be considered the same, the claim language would be repetitive. As recited in the claim and further supported in the Specification, the image information “enables a sender to be specified therefrom.” In contrast, an email address is a domain-based address by which a user is referred to but does not specify the sender. The term “specified” in the claim must be interpreted in light of the specification, and accordingly, the term

provides different type of information from an email address.

Referring to V's Email SIG HTML, this article provides an example of a code to put in an email signature box. See page 1 of V's Email SIG HTML. According to the Office Action, the article shows that an email signature can be an HTML web page that mixes image information with text information. However, the HTML web page does not teach or suggest, "image information, which enables a sender to be specified therefrom," as recited in independent claim 1. Rather, the HTML web page in the image signature is a code. Further, the images that are shown in the article are animated figures, such as a recessed angel background, graphics, or a sound tag. Once the image is on the email, the user may click the image to open another page. See page 5 of V's Email SIG HTML.

Nothing in the article teaches or suggest "a symbol including image information, which enables a sender to be specified therefrom," as recited in independent claim 1. Rather, the purpose of the article is to allow the user to provide a viewer with web access from the email signature box. Thus, assuming, arguendo, that Dawson and V's Email SIG HTML, the combination thereof would not teach or suggest all the claimed features of independent claim 1. The combination would fail to teach or suggest, "electronic mail in which a symbol including image information, which enables a sender to be specified therefrom, is included within an electronic signature file of the electronic mail," as recited in independent claim 1. Similar arguments as presented above are incorporated herein to support the patentability of independent claims 11, 21-24, 26, and 27.

Further, on page 3 of the Office Action, item numbered 9, it is interpreted from the specification that the signature file is defined by the McGuiness article rather than the digital/electronic signatures as defined by the DSS standard. Applicant respectfully asserts that the statement made in the Office Action, item numbered 9, is not correct. Specifically, the signature file discussed in McGuiness article refers to a type of signature file described in the present application. However, the digital/electronic signatures as defined in the DSS standard also include the signature file discussed in the McGuiness article. The signature file, in accordance with an aspect of the present application, is a type of the digital/electronic signatures defined in the DSS standard, specifically, the signature file discussed in the McGuiness article.

*On page 6 of the Office Action, claim 3 was rejected under 35 U.S.C. § 103(a) as being obvious in view of Dawson, V's Email SIG HTML, and U.S. Patent No. 5,432,862 to Lu et al. ("Lu").*

Because claim 3 depends from independent claim 1, the combination of Dawson, V's

Email SIG HTML, and Lu must teach or suggest all the claimed features of independent claim 1. The arguments provided above supporting the patentability of independent claim 1 in view of Dawson and V's Email SIG HTML are incorporated herein. Lu generally describes an apparatus and method to verify an identity of a person by comparing that person's face with a facial image generated using data stored on an identification card, badge, or a tag carried by the person. See column 1, lines 5-10 of Lu. However, similarly to Dawson and V's Email SIG HTML, Lu is silent as to teaching or suggesting, "transmitting electronic mail in which a symbol including image information, which enables a sender to be specified therefrom, is included within an electronic signature file of the electronic mail, said electronic signature file including an email address of the sender," emphasis added, as recited in independent claim 1. Dawson, V's Email SIG HTML, and Lu, individually or combined, fail to teach or suggest, transmitting an electronic mail including image information and an email address.

The Office Action provides absolutely no motivation to combine the cited references. Rather, conclusive statements are made such as "at the time the invention was made, one of ordinary skill in the art would have used the Lu authentication system in order for a user to access the mail account." However, "rejection of patent application for obviousness under 35 USC §103 must be based on evidence comprehended by language of that section, and search for and analysis of prior art includes evidence relevant to finding of whether there is teaching, motivation, or suggestion to select and combine references relied on as evidence of obviousness; factual inquiry whether to combine references must be thorough and searching, based on objective evidence of record." See In re Lee 61 USPQ2d 1430 (CA FC 2002).

Thus, as pointed out in In re Lee, the record must support motivation, i.e., there must be something in the record pointing out where the recited motivation can be found. In addition, there must be some discussion on how that purported motivation or suggestion is even relevant to the reference being modified.

Furthermore, according to MPEP 2143.01, the proposed modification cannot render the prior art unsatisfactory for its intended purpose. Specifically, if Dawson, V's Email SIG HTML, and Lu were combined, the combination would provide an e-mail system automatically "signed" by a thumbnail image of the sender including a code allowing a viewer access to the Internet and able to identify of the viewer by comparing that person's face with a facial image generated using data stored on an identification card, badge, or a tag carried by the person. The combination would be inoperable because there is no link between the email system and the identification card, badge, or tag. The combination of the cited references does not make sense

and does not provide a workable apparatus or system.

Only the present invention sets forth all the claimed features, as well as the motivation for combining the same. The outstanding rejection would appear to have taken this teaching of the present invention and applied the same to generate a combination of Dawson, V's Email SIG HTML, and Lu, as set forth in the Office Action, to disclose the presently claimed invention. Applicant respectfully asserts that the *prima facie* burden has not been met and the obviousness rejection fails on its face.

*On page 7 of the Office Action, claims 6, 9, 14, 15, 17, 18, 25, and 28 were rejected under 35 U.S.C. § 103(a) as being obvious in view of Dawson, V's Email SIG HTML, and WarpSpeedHelp article on Web Page Embedding.*

Because claims 6 and 9 depend from independent claim 1, the combination of Dawson, V's Email SIG HTML, and WarpSpeedHelp must teach or suggest all the claimed features of independent claim 1. Further, because claims 14, 15, 17, and 18 depend from independent claim 11, the combination of Dawson, V's Email SIG HTML, and WarpSpeedHelp must teach or suggest all the claimed features of independent claim 11.

The arguments presented above supporting the patentability of independent claims 1 and 11 in view of Dawson and V's Email SIG HTML are incorporated herein. WarpSpeedHelp generally describes fully decorating emails by embedding a web page, rather than placing all the codes (e.g., V's Email SIG HTML) in the signature box of the WebTV. WarpSpeedHelp, similarly to Dawson and V's Email SIG HTML, is silent as to teaching or suggesting, "transmitting electronic mail in which a symbol including image information, which enables a sender to be specified therefrom, is included within an electronic signature file of the electronic mail, said electronic signature file including an email address of the sender," as recited in independent claim 1. The combination of the cited references fails to teach or suggest all the claimed features recited in independent claim 1. Similar arguments as presented above are incorporated herein to support the patentability of independent claim 11.

Referring to independent claim 25, the cited references fail to teach or suggest, "a display controller controlling said display unit to display the electronic signature file with a format which enables recognition of the importance, based on the information which indicates the importance, said electronic signature file including an email address of a sender," as recited in independent claim 25. Rather, the outstanding rejection would appear to have taken the teachings of the present invention such that a combination of the cited references, as set forth in the Office Action, would disclose the presently claimed invention. The outstanding Office Action

has provided no explicit support of what the purported well-known features encompass or how the determination of those features as being well known has been determined. Rather, the Office Action makes a series of assumptions and self-serving conclusive statements, without pointing how the claimed features have been determined as being well known in view of the cited references.

It is improper to merely deem something obvious without any teaching/suggestion, or the taking of Official Notice. If the U.S. Patent and Trademark Office wishes to take Official Notice that the proposed structural and functional modification is notoriously well known, it is respectfully requested that supporting evidence be provided. The Federal Circuit has cautioned that an Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. In re Rouffet, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998). Because independent claim 5 includes similar claim features as those recited in independent claim 28, although of different scope, the arguments presented above supporting the patentability of independent claim 5 are incorporated herein to support the patentability of independent claim 28. Similar arguments as presented above are incorporated herein to support the patentability of independent claim 28.

**CONCLUSION:**

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

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If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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